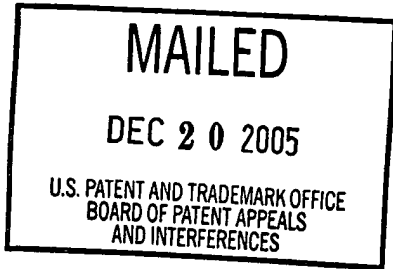


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte FERDINAND SCHERMEL

Appeal No. 2005-2495
Application No. 09/872,914

ON BRIEF

Before McQUADE, NASE and CRAWFORD, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Ferdinand Schermal, acting pro se, appeals from the final rejection (mailed February 24, 2004) of claims 1, 3-6, 9, 10, 22 and 24-26, all of the claims pending in the application.

THE INVENTION

The invention relates to a modular wheeled container system for storing and transporting refuse and recyclable materials.

Representative claim 1 reads as follows:

1. A modular wheeled container system that is tilted from the free standing position for rolling consisting of open top containers that can nest within each other comprising:

a) a wheeled container having a means for rolling, a top interface, a means for securing across the said top interface

b) a first attachable container which rests on top of said wheeled container, having a bottom and top interface and a means for securing across it's top interface

c) an optional second attachable container having a bottom interface which rests on top of first said attachable container, to be added if the combined height of the said wheeled container and said first attachable container do not reach the height necessary for ergonomically comfortable tilting and rolling,

d) a means for securing and lifting with two hands

wherein said means for securing of said wheeled container secures between or across the adjoining interfaces of said top interface of said wheeled container to said bottom interface of said first attachable container wherein a two container single rigid entity is formed from the secured said wheeled container and said first attachable container wherein the said first attachable container becomes the vertical structural extension to allow ergonomically comfortable tilting and rolling of the said two container single rigid entity, and wherein a cart, frame, or vertically extending handle is no longer required, and wherein the tilting shifts the center of gravity of the load vertically above the axis of the said means for rolling and wherein the angle of tilt is greater than 10 degrees between the free standing position and tilted position and whereby the vertical stability is increased without increasing either the effective lifting weight or adding horizontal protrusion to a wheeled container to widen the base to

increase the vertical stability, and wherein the sum of the volumetric capacity of the said first attachable container and the said wheeled container is greater than 25 gallons and wherein the a base perimeter of the wheeled container is greater than 55 inches and wherein the total volume of the said two container rigid entity is greater than 32 gallons, and wherein the said wheeled container can nest within the said first attachable container, and if said second attachable container is needed to reach the height necessary for ergonomically comfortable tilting and rolling, wherein said means for securing of the first attachable container secures between or across the adjoining interfaces of said top interface of said first attachable container to said bottom interface of said second attachable container and wherein a three container single rigid entity is formed from the secured said wheeled container secured to said first attachable container, and said second attachable container secured to said first attachable container wherein said first attachable container and second attachable container become the vertical structural extension to allow ergonomically comfortable tilting and rolling of the said three container single rigid entity, and wherein a cart, frame, or vertically extending handle is no longer required, and wherein the tilting shifts the center of gravity of the load vertically above the axis of the said means for rolling and wherein the angle of tilt is greater than 10 degrees between the free standing position and tilted position, and whereby the vertical stability is increased without increasing the effective lifting weight or adding horizontal protrusion to a wheeled container to widen the base to increase the vertical stability, and wherein the sum of the volumetric capacity of the said first attachable container and the said wheeled container is greater than 25 gallons, and wherein the base perimeter of the wheeled container is greater than 55 inches and wherein the total volume of the said two container rigid entity is greater than 32 gallons, and wherein the said wheeled container can nest within the said first attachable container and said first attachable container can nest within the said second attachable container.

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THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

Tolbert, Jr. (Tolbert)	3,269,580	Aug. 30, 1966
Ferbrache	4,691,840	Sep. 08, 1987
Tiramani et al. (Tiramani '559)	6,176,559	Jan. 23, 2001
Tiramani et al. (Tiramani '847)	6,347,847	Feb. 19, 2002

THE REJECTIONS

Claims 1, 3-6, 9, 10, 22 and 24-26 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the claimed invention.

Claims 1, 3-6, 9, 10, 22 and 24-26 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

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Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over either Tiramani '559 or Tiramani '847.

Claims 3-6, 9, 10 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Tiramani '559 or Tiramani '847 in view of Tolbert.

Claims 24-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Tiramani '559 or Tiramani '847 in view of Ferbrache.

Attention is directed to the main and reply briefs (filed November 19, 2004 and April 15, 2005) and answer (mailed February 18, 2005) for the respective positions of the appellant and examiner regarding the merits of these rejections.

DISCUSSION

I. Petitionable matters

In the briefs, the appellant raises as issues in the appeal the objections to the drawings set forth on pages 3 and 4 in the final rejection under the headings "Drawing Objections" and "Claim Objections." Notwithstanding the appellant's argument to the contrary, these objections are not directly connected with the merits of any standing rejection of claims. Hence, they are reviewable by petition to the Director rather than appeal to this

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Board (see In re Hengehold, 440 F.2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971)), and will not be further addressed in this decision.

II. The 35 U.S.C. § 112, first paragraph, rejection of claims 1, 3-6, 9, 10, 22 and 24-26

The following passage details the examiner's rationale for this rejection:

The specification as originally filed doesn't contain support for a modular wheeled container system comprising a wheeled container, a first attachable container which rests on top of said wheeled container and a second attachable container which rests on top of said first attachable container as recited in claim 1. Also, the base perimeter greater than 55 inches as recited in claim 1 is not supported by the original specification. **This is a new matter rejection** [answer, page 4].

This explanation indicates that the rejection is based on an alleged failure of the specification to comply with the written description requirement of § 112, ¶ 1. The test for compliance with this requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of

the drawings may also be considered in determining compliance with the written description requirement. Id.

With regard to the recitation in appealed claim 1 of the wheeled container, first attachable container and second attachable container, original claims 1 and 2 recited a system comprising a wheeled container, one attachable container, means for securing the wheeled container to the attachable container, and a plurality of attachable containers stacked and secured on top of the attachable container. This portion of the disclosure as originally filed would reasonably convey to the artisan that the appellant had possession at that time of a system embodying a wheeled container and first and second attachable containers as now recited in claim 1.

The original disclosure, however, lacks any apparent support for the recitation in claim 1 that the base perimeter of the wheeled container is greater than 55 inches. The appellant's contention that this feature is shown in the drawings (see, for example, page 11 in the main brief) is not well taken because it rests on unsupported assertions relating to the "well known" base perimeter of the RUBBERMAID 32 gallon refuse container 10 shown in

the drawings and an inappropriate scaling of the wheeled container (presumably wheeled bin 1) relative thereto.¹

Thus, we shall sustain the standing 35 U.S.C. § 112, first paragraph, rejection of independent claim 1 and dependent claims 3-6, 9, 10, 22 and 24-26, but only to the extent that it is based on a lack of written descriptive support for the recitation in claim 1 of the 55 inch base perimeter of the wheeled container.

III. The 35 U.S.C. § 112, second paragraph, rejection of claims 1, 3-6, 9, 10, 22 and 24-26

The examiner considers independent claim 1, and dependent claims 3-6, 9, 10, 22 and 24-26, to be indefinite because

Claim 1 . . . contains an optional limitation, "an optional second attachable container." The metes and bounds of the claim, that is, the scope of the claim can not be determined since it can't be determined if the second attachable container is part of the claim or not.

Claim 1 contains the limitation "the a base perimeter" in line 26. There is no antecedent basis for this term. Claim 1 is confusing because it can't be determined whether applicant is introducing the "base perimeter" element or referring to a previous recitation of the "base perimeter." [answer, page 5].

¹ Patent drawings do not define the precise proportions of the elements depicted and may not be relied on to show particular sizes if (as in the present case) the specification is completely silent on the issue. Hockerson-Halberstadt Inc. v. Avia Group International Inc., 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000).

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The examiner's concern that these particular limitations render the scope of the appealed claims indefinite is unfounded. Claim 1 clearly sets forth the "optional second attachable container" as a component of the claimed modular wheeled container system, with the qualifier "optional" simply pertaining to the subsequently recited conditions under which the second attachable container may or may not be utilized. The recitation of "the a base perimeter," while somewhat garbled due to the apparently inadvertent presence of the word "the," merely introduces the base perimeter feature into the claim.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, rejection of independent claim 1 and dependent claims 3-6, 9, 10, 22 and 24-26.²

² Our review of the appealed claims shows that they are rather unartfully drawn, presumably as the result of inexperience on the part of the pro se appellant. In the event of further prosecution, steps should be taken to reassess these claims to ensure complete compliance with the first and second paragraphs of 35 U.S.C. § 112.

IV. The 35 U.S.C. § 103(a) rejection of claim 1 as being unpatentable over either Tiramani '559 or Tiramani '847

The Tiramani patents pertain to "an apparatus for transporting articles, such as hand tools and similar items, between desired locations" (column 1, 10-12). The following passage fairly describes the apparatus:

. . . [R]olling containers assembly 50 serves for storing working tools and includes a fixed container or base cabinet 52. At its lower aft end base cabinet 52 is supplemented with a pair of ground engaging wheels 54. At its aft base cabinet 52 includes a manually engageable handle 56. Wheels 54 and handle 56 serve for locomoting assembly 50. Together, the cabinet 52, the wheels 54, and the handle [56] may be considered a wheeled device.

Pulling handle 56 is shaped, sized and designed to assist a user to pull assembly 50. For example, its upper part is designed to comfortably accept the hand of the user, and is therefore supplemented with four finger accepting recessions 51.

Rolling containers assembly 50 further includes at least one additional cabinet 58 in the form of a removable container. Additional cabinet 58 is removably connectable on top of base cabinet 52. Specifically, the upper surface of the base cabinet 52 provides container supporting structure and the additional cabinet 58 is removably mounted atop this structure.

As further detailed hereinbelow, according to a preferred embodiment of the invention handle 56 is extendible/retractable.

As further detailed hereinbelow, according to another preferred embodiment of the present invention,

additional cabinet(s) 58 include, for example, a drawers assembly 60 and/or a toolcase 62.

As further detailed hereinbelow, according to another preferred embodiment of the present invention base cabinet 52 is supplemented with a coil storage device in the form of a reel 64.

As best seen in FIG. 12 additional containers 58 are preferably designed modular, such that any combination thereof is deployable over base cabinet 52 or as a standalone configuration. Thus, for example, a plurality of drawer assemblies 62 may be snapped together as an independent drawers tower system with keyholes 63 formed in the rear for wall mounting.

Connecting any of additional cabinet(s) 58 to base cabinet 52 preferably involves snapping. To this end, base cabinet 52 and the additional cabinet(s) 58 are designed snappable to one another, and, to this end, are supplemented with snapping mechanisms 66, which preferably also serve as side claw latches for providing extra stability. [Tiramani '559, column 7, lines 4-48; also see Tiramani '847, at column 7, lines 16-61].

The examiner concedes that neither Tiramani reference teaches a system meeting the limitations in independent claim 1 requiring the base perimeter of the wheeled container to be greater than 55 inches and the total volume of the two container rigid entity to be greater than 32 gallons. Nonetheless, the examiner submits that

[t]rash containers of 32 gallon capacity and 55 inch base perimeter are well known. It would have been obvious by engineering design choice to modify the size of the [Tiramani] container to be 32 gallons in order to make the volume correspond to any quantity desired. No criticality has been assigned to the 32 gallon capacity. It would have been obvious by engineering design choice to modify the size of the base perimeter to be greater

than 55 inch to have a base which is large enough in perimeter and area to be stable to be stacked upon without concern of the stack toppling. No criticality has been assigned to the 55 inch perimeter dimension [answer, pages 5 and 6].

This reasoning is flawed from the outset, however, because the Tiramani system does not involve trash containers. Moreover, it is of no moment that the limitations in question may not be critical. Claims are not legally required to include critical limitations. W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Thus, as applied by the examiner, neither of the Tiramani patents provides the factual basis necessary to conclude that the admitted differences between the subject matter recited in claim 1 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1 as being unpatentable over either Tiramani '559 or Tiramani '847.

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V. The 35 U.S.C. § 103(a) rejection of claims 3-6, 9, 10 and 22 as being unpatentable over either Tiramani '559 or Tiramani '847 in view of Tolbert

As the examiner's citation of Tolbert does not overcome the above discussed deficiencies of either Tiramani patent relative to the subject matter recited in parent claim 1, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 3-6, 9, 10 and 22 as being unpatentable over either Tiramani '559 or Tiramani '847 in view of Tolbert.

VI. The 35 U.S.C. § 103(a) rejection of claims 24-26 as being unpatentable over either Tiramani '559 or Tiramani '847 in view of Ferbrache

Since the examiner's application of Ferbrache does not cure the above noted shortcomings of either Tiramani patent relative to the subject matter recited in parent claim 1, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 24-26 as being unpatentable over either Tiramani '559 or Tiramani '847 in view of Ferbrache.


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SUMMARY

As one rejection of claims 1, 3-6, 9, 10, 22 and 24-26 is sustained, the decision of the examiner to reject these claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED


JOHN P. McQUADE
Judge of the Superior Court of the State of California


JEFFREY V. NASE
Administrative Patent

MURRIEL E. CRAWFORD
Administrative Patent J

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